

Orhomuru, Sunday  
Appl. No.: 09/862,789  
Page 17 of 20

Filed: September 21, 2001 Atty. Docket No. 06-0713-SOR.RA

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**REMARKS/ARGUMENTS**

**Specification**

Applicant has amended the specification for clarity only, to include recommended headings and to correct typographical errors.

**102(e) Rejections**

The Examiner has rejected claims 1 and 2 under 35 U.S.C. 102(e) as anticipated by Christensen (U.S. Patent No. 6,662,193). Applicant respectfully traverses.

Applicant has amended claim 1 to include the further limitations of MIME type HTML elements combined with scripting language elements to dynamically generate a web each time it is requested by a browser. Applicant has amended claim 2 to contain the further limitation of exclusion of personal data from the displayed web page. This is disclosed in the Detailed Description portion of the specification at lines 8 through 18, as amended above.

Christensen '193 does not disclose the use of MIME type HTML elements combined with scripting language; nor does it disclose dynamically generating a web page. Lastly, Christensen '193 does not teach exclusion of personal data from a browsed web page. In view of the above amendments, Applicant respectfully believes that amended claims 1 and 2 distinguish over Christensen '193, and are now in condition for allowance.

**103(a) Rejections**

The Examiner has rejected claims 3 and 4 under 35 U.S.C. 103(a) as unpatentable over a combination of Christensen (U.S. Patent No. 6,662,193) and Covington et al. (U.S. Pat. Appl. Ser. No. 2003/0154135). Applicant respectfully traverses.

**The Examiner has not established a *prima facie* case for obviousness.** Obviousness over a combination of references requires a motivation or suggestion within the references for the combination. "Obviousness cannot be established by combining the teachings of the prior art

Orhomuru, Sunday

Appl. No.: 09/862,789

Filed: September 21, 2001

Atty. Docket No. 06-0713-SOR.RA

Page 18 of 20

to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). “To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) [Emphasis added].

Neither reference cited by the Examiner was available to the Applicant or to the public at the time that Applicant filed the instant application. Accordingly, no one skilled in the relevant art would have had access to the references, and, thus, would not have had motivation or suggestion to combine them. Such reason, namely the unavailability of references, is also well established as the reason that references from non-analogous fields of art cannot be combined; that is, one skilled in the art of a subject invention will not be aware of references in another field of art, and, thus, the references are unavailable. Unpublished references, as in the instant case, are just as unavailable.

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.” In re Lintner, 458 F.2d 1013,

Orhomuru, Sunday

Appl. No.: 09/862,789

Filed: September 21, 2001

Atty. Docket No. 06-0713-SOR.RA

Page 19 of 20

1016 (C.C.P.A. 1972) [Emphasis added]. No one of ordinary skill in the relevant art could have had the references before him, since neither had been published or was otherwise available. The Examiner has not shown how one of ordinary skill in the relevant art, without the references before him, would be motivated to combine them.

Further, even had the references been available, there is no motivation or suggestion in the references, express or implied, to modify or combine them, and the Examiner has not identified any. As stated by the Court of Customs and Patent Appeals, "Absence of any suggestion in either Pengilly or Munro that features of the process of one should be combined with features of the other to achieve the commercial scale production of which neither is capable requires a holding that the rejection herein was improper." In re Rinehart, 531 F.2d 1048, 1054 (C.C.P.A. 1976). "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Since the Examiner has not met the requirement of a *prima facie* case of obviousness, "[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Further, "[t]o reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. See In re Deuel, 51 F.3d 1552, 1557, 34 U.S.P.Q.2D (BNA) 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Accordingly, Applicant respectfully believes that amended claims 3 and 4 are in condition for allowance.

DEC 08 2006

Orhomuru, Sunday

Appl. No.: 09/862,789

Filed: September 21, 2001

Atty. Docket No. 06-0713-SOR.RA

Page 20 of 20

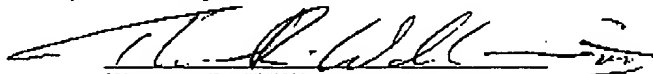
CONCLUSION

No new matter has been added. Applicant respectfully believes that that the application is now in condition for allowance. Should the Examiner require further clarification of the claims, Applicant respectfully requests that Applicant be afforded additional time to make such clarifications.

If the Examiner disagrees with Applicant's position and would like to receive further clarifying explanations of the significance of Applicant's invention, it is respectfully requested that Applicant's undersigned attorney be granted a telephone interview with Examiner.

Otherwise, should the Examiner have any questions regarding this submission, she is invited to contact the undersigned counsel at the telephone number below.

Respectfully submitted, this 8<sup>th</sup> day of December, 2006,



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